IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of

KETTUNEN — Atty. Ref.: 10-1304

Serial No. 09/533,904 — TC/A.U.: 3689

Filed: March 21, 2000 — Examiner: Nguyen

For: COOKING CELLULOSE MATERIAL USING HIGH ALKALI CONCENTRATIONS AND/OR HIGH PH NEAR THE END OF THE COOK

* *

May 27, 2009

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Commissioner for Patents
P.O. Box 1450
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REPLY BRIEF

The Supplemental Examiner's Answer dated March 31, 2009, failed – after over a **half-decade** of delay – to address the singular question posed by the Board in its remand decision dated July 31, 2003. The Supplemental Examiner's Answer, which ignores the Board's express instructions, instead addresses the arguments raised in Applicant's Reply Brief dated September 16, 2002.

Even if not repeated herein, Applicant fully reiterates and stands on the arguments made in the initial Appeal Brief filed April 29, 2002.

The Board's 2003 Remand Decision to Address *Ex Parte Eggert*

On July 31, 2003, the Board remanded the application "to the examiner for appropriate action." (Remand dated July 31, 2003, at 1) The Board specifically noted that a precedential opinion in another reissue case had very recently (at least at that point) been decided and that case "applied the fact-specific analysis set forth in *In re Clement*,

131 F.3d 1464, 1468-74, 45 USPQ2d 1161, 1164, 1164-66 (Fed. Cir. 1997)." (*Id.* at 2.)

Even though Applicant had applied *Clement* to the present circumstances in the initial Appeal Brief, it was not addressed by the Examiner. Thus, the Board specifically requested an application of *Clement* and *Ex Parte Eggert* (in which the Board applied *Clement*):

> We remand this application to the examiner for a determination of whether the rejection under 35 U.S.C. § 251 remains appropriate in view of *Ex parte Eggert*.
>
> If the examiner determines that the rejection under 35 U.S.C. § 251 remains appropriate, the examiner is authorized to prepare a supplemental examiner's answer specifically addressing the § 251 rejection. See 37 CFR § 1.193(b)(1). . . .
>
> If the examiner determines that the rejection under 35 U.S.C. § 251 is no longer appropriate, the examiner should withdraw the rejection in an appropriate Office action.

(*Id.* at 2-3 (underscoring added).)

Thus, the Board limited its remand to applying *Eggert* to the present circumstances.

Cognizant that this reissue application was filed in 2000 (and had been pending for just over three years at that point), the Board instructed that "[t]his application, by virtue of its 'special status' requires immediate action." (*Id.* at 3.) No action, however, was taken until Spring 2009, despite a number of Status Inquiries filed by Applicant. (*See, e.g.*, Fourth Status Inquiry dated August 18, 2008.)

The Supplemental Examiner's Answer Is an Improper Sur-Reply

Despite the express remand instructions and despite the excessive delay, the Supplemental Examiner's Answer does not address *Clement* or *Eggert*. Rather, a

verbatim copy of the first Examiner's Answer was re-filed with the addition of this puzzling two-sentence paragraph addressing Applicant's Reply Brief:

> Applicant's comment on the Applicant's Reply Brief of 9/16/02, second paragraph, that amendment was presented in patent claim 16 so as to define the EA concentration of the liquor during the last 15 minutes of the cook to be 20-40 g/l vs. 18-40 g/l as original filed, and no amendment was submitted to claim 16 which limited the EA concentration between the cooking liquors at the beginning of the first and second cooking zones is not persuasive because the last phrase of step (e), "the spent second cooking liquor having an effective alkali concentration expressed as NaOH or equivalent of greater than about [15]20 g/l" which is critical to the cooking condition of step (e). Current claim 47 is silent with respect to this limitation which is considered as an improper recapture of claimed subject matter.

(Supplemental Examiner's Answer dated March 31, 2009, at 4 (emphasis original).) At best, this solely addressed Applicant's Reply Brief, and thus did not resolve the Board's remand query. Indeed, the Supplemental Examiner's Answer is an improper sur-reply brief – a paper that is not authorized by the Rules.

Regardless, the additional paragraph merely repeats the same erroneous understanding of recapture law and the claims as previously set forth in the initial Examiner's Answer.

Applicant Again Urges That the Examiner's Answer Misapplies the Law

As previously argued, the Examiner's Answer – both the initial Answer and the "Supplemental" Answer – misunderstands the claims:

> This Brief is being submitted in reply to the Examiner's Answer dated July 15, 2002. An oral hearing was previously requested with the Applicant's Appeal Brief dated April 29, 2002. Such oral hearing request is hereby reaffirmed.
>
> The Examiner's comments in his Answer of July 15, 2002, appear to focus on the EA concentrations in step (d) and (e). In this regard,

> the Examiner attempts to draw parallels to the presently claimed reissue subject matter to support his conclusion that improper recapture under 35 USC §251 is being pursued. Applicant again emphasizes that it is the EA concentration between the ***cooking*** liquors ***at the beginning of the first and second cooking zones*** that is being defined in independent claim 47 pending herein. In contrast, the EA concentrations in step (e) referenced by the Examiner to support the rejection under 35 USC §251 are to the ***spent*** cooking liquor from the ***second cook zone***. Furthermore, while amendment was presented in patent claim 16 so as to define the EA concentration of the liquor during the last 15 minutes of the cook to be 20-40 g/l vs. 18-40 g/l as originally filed, it should be clear that ***no*** amendment was submitted to claim 16 which limited the EA concentration between the cooking liquors at the ***beginning*** of the first and second cooking zones. Indeed, claim 16 retained the language that the second cooking liquor have a second EA concentration of greater than about 25 g/l and greater than the first EA concentration.
>
> Hence, applicant again submits that the alleged improper broadening asserted by the Examiner relates to an aspect of the claim that was ***never narrowed*** during prosecution in order to overcome the prior art. As such, the proscription against recapture of subject matter does not apply to the present application. Withdrawal of the rejection advanced against 35 USC §251 is therefore in order.
>
> Such favorable decision on the merits continues to be solicited.

(Reply Brief filed September 16, 2002, at 1-2 (emphasis original).)

CONCLUSION

In conclusion it is believed that the application is in clear condition for allowance; therefore, early reversal of the Final Rejection and passage of the subject application to issue are earnestly solicited.

Respectfully submitted,

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